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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/727,998

Applicant(s)

MITRA ET AL.

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33,34 and 45-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33,45,50-54 and 59-64 is/are rejected.
- 7) ☒ Claim(s) 34,46-49,51,52, 55-58, and 60-62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

Art Unit: 1755

### **DETAILED ACTION**

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

#### ***Claim Objections***

Claims 51, 52, and 60-62 are objected to because of the following informalities:

Claims 51 and 52 depend from claim 45, which uses closed claim language, “consists of”. Claims 51 and 52 recite, “further consists of”, which appears to add additional components. However, no new component is added, rather the previously recited refining agent is further limited. It would be clearer if the claims were amended to read “...zinc-containing optical glass, wherein up to a total of about 1% by weight of refining agents are present.”

Claim 60 depends from claim 54, which uses closed claim language “consists of”. Claim 60 recites, “further consists of”, which appears to add additional components. However, no new component is added, rather the previously recited coloring component is further limited. It would be clearer if the claim were amended to read “...zinc-containing optical glass, wherein up to about 8% by weight of a coloring components;”

Claim 61 and 62 depend from claim 54, which uses closed the claim language “consists of”. Claims 61 and 62 recite, “further consists of”, which appears to add additional components. However, no new component is added, rather the previously recited refining agent is further

Art Unit: 1755

limited. It would be clearer if the claims were amended to read "...zinc-containing optical glass, wherein up to a total of about 1% by weight of a refining agents;"

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 45, 50-54, and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hares et al., U.S. Patent 6,184,166.

Hares et al. teach a glass composition having overlapping ranges of components with instant claims 45, 51-54, and 60-63. See abstract of Hares et al. and column 2, lines 2-10.

Hares et al. fail to teach any anticipatory examples or compositional ranges and optical properties sufficiently specific to anticipate the instant invention. However, Hares et al. teach ranges of components, which overlap instant claims 45, 51-54, and 60-63. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges taught by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Art Unit: 1755

The reference fails to teach the refractive index, Abbe number, and transmission of instant claims 45, 50, 54, and 59. However, one of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same refractive index, Abbe number, and transmission as recited in claims 23 and 25.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tachibana et al., U.S. Patent 4,472,030.

Tachibana et al. teach an optical glass composition having overlapping ranges of components with instant claim 33. See abstract of Tachibana et al. and column 4, lines 58-60. Tachibana et al. teach that the optical glass can be used as a light converging lens. See abstract.

Tachibana et al. fail to teach any anticipatory examples or compositional ranges and optical properties sufficiently specific to anticipate the instant invention. However, Tachibana et al. teach ranges of components, which overlap instant claim 33. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges taught by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The reference fails to teach the Abbe number and refractive index of instant claim 33. However, one of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same Abbe number, and refractive index as recited in claim 33.

Art Unit: 1755

Claims 54, 59, and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speit, U.S. Patent 4,820,326.

Speit teaches an optical filter glass composition having overlapping ranges of components with instant claims 54 and 61-63. See abstract and column 2, lines 25-37 and 49-52.

Speit fails to teach any anticipatory examples or compositional ranges and optical properties sufficiently specific to anticipate the instant invention. However, Speit teaches ranges of components, which overlap instant claims 54 and 61-63. Overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges taught by the reference because overlapping ranges have been held to establish *prima facie* obviousness. See MPEP 2144.05.

The reference fails to teach the light transmission, Abbe number and refractive index of instant claims 54 and 59. However, one of ordinary skill in the art would expect that a glass with overlapping compositional ranges would have the same light transmission, Abbe number, and refractive index as recited in claims 54 and 59.

#### ***Allowable Subject Matter***

Claims 34 and 46-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments, see page 25, filed 29 September 2003, with respect to the rejection of claims 25, 30, 31, 36, and 40-44 over Tachibana et al. have been fully considered and are persuasive. The rejection of claims 25, 30, 31, and 40-44 over Tachibana et al. has been withdrawn.

However, in further review of the amended claims over Tachibana et al. amended claim 33 is now rejected, and the Examiner will address the arguments with respect to that claim.

Applicants argue that the glass of Tachibana et al. requires 6-32 wt% of  $\text{Cs}_2\text{O}$ . However, instant claim 33, does not limit the amount of  $\text{Cs}_2\text{O}$  present in the glass.

While the Examiner had previously indicated that claims 32-35 would be allowable if written to include the limitations of the base claim and any intervening claim, upon further review of the prior art, instant claim 33 is now rejected over Tachibana et al., since Tachibana et al. teach that up to 2.5 wt %  $\text{PbO}$  can be included in the glass. See column 4, lines 58-60 and above rejection.

Applicant's arguments in view of the rejection over Speit, filed 29 September 2003 have been fully considered but they are not persuasive.

Applicants argue that the glass of Speit comprise  $\text{SnO}_2$ ,  $\text{NiO}$ , and  $\text{CoO}$  as required components, and that instant claims 45 and 56, do not recite  $\text{SnO}_2$ ,  $\text{NiO}$ , and  $\text{CoO}$  as components. This is not deemed persuasive since independent claim 54, allows for the presence of coloring components.  $\text{SnO}_2$ ,  $\text{NiO}$ ,  $\text{CoO}$  are glass colorants. See above rejection and column

Art Unit: 1755

2, lines 25-37 and 49-52. Furthermore, claims 59 and 61-63 depend from claim 54 and do not further limit the amount or type of colorants present in the instant invention.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 9:30 am-7:00 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

After the move to the new USPTO headquarters in Alexandria, Virginia, tentatively scheduled for the week of December 22, 2003, the examiner's new phone number will be (571) 272-1363 and Mark Bell's new phone number will be (571) 272-1362.

  
DAVID SAMPLE  
PRIMARY EXAMINER

EAB  
11 December 2003